

REMARKS

Applicant submits this Amendment and Response in reply to the Official Action dated September 17, 2010. Applicant submits that this Amendment and Response is fully responsive to the Official Action for at least the reasons set forth herein.

Claims 28, 29, 32, 33, 36 and 38 have been amended. Specifically, independent claims 28, 29, 32 and 33 have been amended to recite, *inter alia*, a current active communication network while a call subject to a potential handover is in progress. Claims 36 and 38 have been amended for consistency. Applicant submits new claim 39 for examination. Claim 39 recites, *inter alia*, comparing the received first list with a second list stored in the user equipment, said second list including at least one network identifier being an identifier of a network that is never to be used. No new matter has been added to the application by way of the aforementioned amendments. For example, Applicant respectfully directs the Examiner's attention to pages 3- 4 and 9-10 of the instant application. The identified sections of the application are only presented for the Examiner's convenience, by way of example, and are not intended to be an exhaustive list.

Claims 28, 29, 33-38 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Lynch. Applicant respectfully submits that Lynch does not anticipate the claimed invention because it fails to teach each and every limitation of the claims. For example, Lynch fails to teach receiving a message on said user equipment including a first list including a plurality of network identifiers corresponding to a plurality of available networks for a potential handover, said receiving from a current active communication network while a call subject to a potential handover is in progress, as recited in independent claim 28 and similarly recited in each of the other independent claims.

Notably, Lynch teach downloading a list of updated **preferred** SID. *See* Col. 16, lines 21-46. This is not a list of **available** networks. An available network is not necessarily preferred. Accordingly, for this reason alone, Lynch fails to anticipate the claimed invention.

Furthermore, while Lynch teaches that the system will complete a call to the mobile subscriber unit informing that unit that the SID table is being downloaded through a voice channel; the call is not a call subject to a potential handover. In Lynch, the call is part of the updating protocol. It is a special or dedicated call. Lynch states that the network “complete[s] a call to the mobile subscriber unit informing that the SID table is being downloaded through a voice channel”. In fact, a regular call, i.e., call subject to a potential handover, would not be able to be made during the updating since the channels are used by the updating, one for the downloading and the other for the notification.

Notably, Lynch explicitly states that the overhead message can be used to direct subscriber units to tune to another frequency capable of handling the data content of the updated preferred SID list of download. In fact, Lynch states:

[o]ne technique for carrying out the updated preferred SID list download to subscriber units would be to send the update information as part of the normal overhead message that all mobile units receive during their normal operation. However, this technique would require changes in the cellular industry standards. This is a long and involved process and may not be considered feasible for the near future.

Col. 15, lines 40-49.

This suggests that Lynch does not download the list during a call subject to a potential hand over, but rather the download occurs when the mobile equipment is idle (other than receiving the notification of the download). In fact, Lynch explicitly teaches away from even

having the download during normal overhead messaging. This would also teach away from having the download during normal messaging, i.e., a call subject to a potential handover.

Accordingly, Lynch fails to teach each and every limitation of the independent claims; therefore, claims 28, 29 and 33 are patentable over Lynch. Claims 34-38 are patentable over Lynch based at least upon the above-identified analysis and in view of their dependency, whether directly or indirectly, from claim 28.

Furthermore, Applicant submits that Lynch fails to teach wherein said message is periodically transmitted by said current active network without a specific request, as recited, *inter alia*, in claim 35. Notably, Lynch explicitly teaches that the updated SID list is downloaded when the subscriber initiates a download. Only a character representing a list is inserted into the normal overhead message. *See* Col. 15, lines 50-52. Moreover, "an additional overhead message could contain information directing the mobile subscriber to tune to a voice channel for the updated preferred SID list download." Col 15, lines 62-65.

Claim 32 was rejected under 35 U.S.C. § 103(a) as allegedly obvious over Lynch, in view of Daly, U.S. Patent No. 6,122,503 and further in view of I, U.S. Patent No. 6,088,335. Without acquiescing to the propriety of the interpretation of Daly and I, Applicant submits that these references fail to cure the above-identified deficiencies. Accordingly, claim 32 is patentable over the cited references, whether taken alone or in any proper combination thereof based at least upon the above-identified analysis.

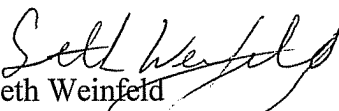
Applicant submits that new claim 39 is patentable over the cited references based at least upon the above-identified analysis.

Accordingly, withdrawal of the rejection of claims 28, 29 and 33-38 pursuant to 35 U.S.C. § 102(b) is respectfully requested as the claims are not anticipated by Lynch. Withdrawal

of the rejection of claim 32 pursuant to 35 U.S.C. § 103(a) is respectfully requested as the claim is not obvious in view of the cited references. Allowance of new claim 39 is respectfully requested.

For at least the reasons set forth in the foregoing discussion, Applicant believes that the Application is now in condition for allowance, and respectfully requests that the Examiner issue a Notice of Allowability. Should the Examiner have any questions regarding this Amendment, or regarding the Application generally, the Examiner is invited to telephone the undersigned attorney.

Respectfully submitted,


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